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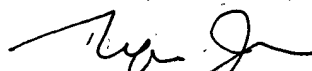
Re: **Application Serial No.:** 09/193,647
Confirmation No.: 2284
Appellants: Usner, et al.
Title: Apparatus and Method for Indicating the Status
of Transaction Function Devices in an
Automated Banking Machine
Docket No.: D-1077+11

Sir:

Please find enclosed the Reply Brief of Appellants pursuant to 37 C.F.R. § 1.193(b) in triplicate, in response to the Examiner's Answer dated April 10, 2002, for filing in the above-referenced application.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with the filing of the Reply Brief and any other fee due to Deposit Account 09-0428.


Very truly yours,


Ralph E. Jocke
Reg. No. 31,029

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I hereby certify that this document and the documents indicated as enclosed herewith are being deposited with the U.S. Postal Service as Express Mail Post Office to addressee in an envelope addressed to Board of Patent Appeals and Interferences, Commissioner for Patents, Washington, D.C. 20231 this 30th day of April 2002.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)	
Usner, et al.)	
)	Art Unit 2161
Serial No.: 09/193,647)	
)	
Filed: November 17, 1998)	Patent Examiner
)	Pierre Eddy Elisca
For: Apparatus and Method for)	
Indicating the Status of)	
Transaction Function Devices)	
in an Automated Banking Machine))	

Board of Patent Appeals and Interferences
Commissioner for Patents
Washington, D.C. 20231

REPLY BRIEF OF APPELLANTS PURSUANT TO 37 C.F.R. § 1.193(b)

Sir:

The Appellants hereby submit their Reply Brief pursuant to 37 C.F.R. § 1.193(b), in triplicate, concerning the above-referenced Application.

REMARKS

The Examiner's Answer ("Answer") dated April 10, 2002 is acknowledged.

The New Ground Of Rejection

Appellants note that in the Final Office Action dated August 14, 2001, from which their appeal was taken, claim 10 was neither objected to or rejected. It followed that for purposes of their appeal the status of claim 10 was considered as allowed. However, in the Answer a new rejection of claim 10 (and a reliance on the Zeanah reference) improperly appears.

The Office's own procedures for examination clearly state that in order to enter a new ground of rejection after Appellants' Brief has been filed, the examiner, with supervisory approval, must reopen prosecution. Note MPEP § 1208.01 and 1208.02. However, there is no indication that prosecution has been reopened. Nor is there any indication of supervisory approval for reopening prosecution.

Furthermore, a reference cited for the first time in an Examiner's Answer generally will constitute a new ground of rejection (MPEP § 1208.01). Appellants respectfully submit that the manner in which the new reference Zeanah was cited, discussed, and applied clearly constitutes an impermissible new ground of rejection within the meaning of 37 CFR §.1.193(a)(2) which clearly prohibits the entry of a new ground of rejection in an Examiner's Answer. Therefore the citation, discussion, and application of the Zeanah reference in the Examiner's Answer is legally improper due to noncompliance with the clear wording of both the statute and the regulations and the Office procedures promulgated thereunder. Additionally, the presentation of a new ground of

rejection after prosecution has been (and remains) closed, shows disregard of the statutes, rules, and required Office procedures.

Nevertheless, the Appellants, in spite of the Office's improper actions, desire to prevent prosecution delay. Therefore, Appellants regard claim 10 as rejected under 35 U.S.C. § 103(a) as being unpatentable over BankNet in view of Zeanah. Appellants reserve all rights to respond to the new rejection of claim 10. As shown in more detail herein, claim 10 is allowable.

As discussed in the Appeal Brief, the Office's refusal to enter the amendment after final rejection was legally improper and unfair. The Appellants have further brought to the attention of the Board of Patent Appeals and Interferences the legally improper and unfair action by the Office relating to the new grounds of rejection after Appellants' Brief was filed. Nevertheless, Appellants respectfully assert that a review by the Board of Patent Appeals and Interferences of the pending rejections will show that these heretofore legally improper and unfair actions by the Office are merely reflective of all the rejections on appeal. As discussed in more detail in the Appeal Brief, all of Appellants' pending claims are allowable.

The BankNet Article Does Not Constitute Prior Art

As discussed in more detail in the Appeal Brief (e.g., Appeal Brief pages 10-12), the BankNet article does not constitute prior art or a prior art printed publication. The failure by the Office to rebut Appellants' contentions that the BankNet article does not constitute prior art constitutes Agency action under the Administrative Procedures Act acknowledging that the reference is not prior art. That is, the Action's failure to present rebutting evidence regarding the

legality of the BankNet article as a prior art reference has been taken as an admission by the Office that the BankNet article does not constitute prior art. It follows that the BankNet article cannot anticipate or render obvious any of the claims.

Rebuttal Of Remarks In The Examiner's Answer

The Answer at pages 3-5 includes remarks concerning the rejections of claims 1-6, 9-10, and 14-19.

Claims 1-5

The Answer states (paragraph bridging pages 3 and 4) with regard to claims 1-5 that "it is inherent to know that in order for tickets to be printed out at ATM, a server and HTML document is inherently required in order to interact via the Internet at the ATM." The Appellants respectfully disagree. The Appellants have already addressed this issue on at least pages 15 and 16 of the Appeal Brief. As previously discussed, the ATMs in the BankNet article are in an intranet, not the Internet. One having ordinary skill in the art would know that an intranet is not the Internet. The BankNet article uses an intranet "to ensure privacy and avoid delays" (page 1, second to last paragraph which begins with "The ATMs") and for reasons of security and quick transactions (page 2, paragraph 7 which begins with "Besides being").

Furthermore, machines such as ATMs as early as the mid-1980s (i.e., before the advance of the Internet) could print tickets without use of HTML. The Appellants have also addressed this issue on at least pages 15 and 16 of the Appeal Brief. The Appeal Brief even refers the

Office to U.S. Patent No. 5,240,368 as additional evidence. The Office has not proved through citation to prior art that the feature alleged to be inherent is "necessarily present" in the BankNet article. Thus, the Answer's statement that "it is inherent to know that in order for tickets to be printed out at ATM, a server and HTML document is inherently required in order to interact via the Internet at the ATM" is without basis. It follows that the BankNet article cannot anticipate the claims.

Furthermore, as previously discussed in the Appeal Brief, the BankNet article is not concerned with the status of any transaction function device, especially a transaction function device of an automated transaction machine. The BankNet article does not even hint at using an HTML document in (corresponding) relation to the status of a transaction function device.

Claims 6, 9, and 14-15

The Answer states (on page 4) that issues relating to claims 6, 9, and 14-15 are inherently disclosed by the BankNet article and the Official notice. The Appellants respectfully disagree. The Appellants have already addressed these claims on at least pages 22-28 of the Appeal Brief. As previously discussed, the BankNet article does not inherently teach the recited features and relationships. Furthermore, the Office has a duty to produce evidence in support of an Official notice when challenged. MPEP § 2144.03. The allegation of Official notice was traversed (challenged) by Appellants in the amendment filed May 21, 2001 and the Appeal Brief. The Office had ample opportunity to produce evidence in support of the alleged Official notice. However, the Office has still failed to produced any evidence in support of the Official notice.

The failure by the Office to produce evidence in support of the Official notice constitutes Agency action under the Administrative Procedures Act acknowledging lack of evidence of support.

That is, the Action's failure to produce evidence in support of the alleged Official notice has been taken as an admission by the Office that the needed evidence of support does not exist. It follows that the alleged Official notice cannot be used to render obvious the claims.

Claim 10

As previously discussed, the BankNet Article does not constitute prior art against the claimed invention.

Claim 10 depends from claim 8 which depends from claim 7. Claim 10 further recites that in the recited method the accessing step includes accessing the first document, which is an HTML document which includes instructions corresponding to the status of a transaction function device of an automated transaction machine, through a network with a terminal located remotely from the automated transaction machine. Neither the BankNet article nor Zeanah, taken alone or in combination, disclose or suggest the features and relationships that are specifically recited in claim 10. Appellants respectfully submit that Zeanah cannot overcome the previously discussed (in the Appeal Brief) deficiencies of the BankNet article, as it does not disclose or suggest the recited features and relationships which are not found in the BankNet article.

The Answer (on pages 4 and 5) alleges that Appellants argued that the prior art of record does not teach or suggest "accessing an HTML document which includes instructions corresponding to the status of a transaction." However, the Appeal Brief viewed claim 10 as an

allowed claim without any need for argument. Thus, the Answer's allegation of a specific argument in the Appeal Brief regarding claim 10 is unclear. Furthermore, the Office misinterprets the claim because claim 10 is actually directed to remotely accessing an HTML document which includes instructions corresponding to the status of a transaction function device of an automated transaction machine. The claim is not directed to the Office's simplified allegation of "corresponding to the status of a transaction."

Nevertheless, Appellants again wish to point out that claim 10 is specifically directed to remotely accessing an HTML document which includes instructions corresponding to the status of a transaction function device of an automated transaction machine. Nothing in the BankNet article or Zeanah discloses or suggests doing this. In addition, no prior art has been cited as providing any teaching, suggestion, or motivation so as to produce the claimed invention. Thus, the Office has not presented a *prima facie* showing of obviousness. For these reasons it is respectfully submitted that claim 10 is further allowable.

Claims 16-19

The Answer, in response to claims 16-19, states (on page 5) that Appellants argue that Vak does not teach or suggest "an ATM that is operative, responsive to the occurrence of a malfunction of a transaction function device." Again, the Office misinterprets (by simplifying) Appellants' arguments and the claims. Appellants' arguments (Appeal Brief page 30) actually stated that "Vak does not disclose or suggest having a computer in an ATM that is operative, responsive to the occurrence of a malfunction of a transaction function device, to include indicia

in an HTTP record representative of the malfunction. Nor does Vak disclose or suggest a communications connection to the computer which enables an HTTP record, which includes the indicia representative of the malfunction, to be externally accessed."

The Answer relies on Vak's Abstract, admits that Vak does not disclose or suggest "a HTTP record representative of the malfunction", and further relies on an Official notice.

As previously discussed in the Appeal Brief, Vak is not concerned with the occurrence of a malfunction of a transaction function device, or the ability to include indicia in an HTTP record representative of the malfunction, or the ability to enable an HTTP record having indicia to be externally accessed. The Office has not presented a *prima facie* showing of obviousness.

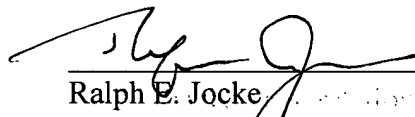
Furthermore, as previously discussed, the Office had ample opportunity to produce evidence in support of the alleged Official notice. The failure by the Office to produce evidence in support of the alleged Official notice constitutes Agency action under the Administrative Procedures Act acknowledging lack of evidence of support. That is, the Action's failure to produce evidence in support of the alleged Official notice has been taken as an admission by the Office that the needed evidence of support does not exist. It follows that the Official notice cannot be used to render obvious the claims.

Appellants respectfully submit that the Action's attempts to modify Vak are clearly attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. Again, the Office has not presented a *prima facie* showing of obviousness.

CONCLUSION

Each of Appellants' pending claims specifically recites features, relationships, and/or steps that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any teaching, suggestion, or motivation for combining features of the applied art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



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